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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/508,794

06/01/2000

Glenn Rolus Borgward

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IP STRATEGIES  
12 1/2 WALL STREET  
SUITE E  
ASHEVILLE, NC 28801

EXAMINER

DHARIA, PRABODH M

ART UNIT

PAPER NUMBER

2629

MAIL DATE

DELIVERY MODE

01/27/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/508,794	<b>Applicant(s)</b> BORGWARD, GLENN ROLUS	
	<b>Examiner</b> PRABODH M. DHARIA	<b>Art Unit</b> 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 212,213,215-223 and 225-229 is/are pending in the application.
- 4a) Of the above claim(s) 1-211,214 and 224 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 212,213,215-223 and 225-229 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **Response to Amendment**

1. The amendment filed 01-06-2011 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: **applicant has failed to point out specific page and paragraphs the amendments (specifically claim limitations “re-programming of operating elements from an initial state to a selection state, enabled by a providing function triggered by an operating element”) are disclosed and in event applicant failed to point out specific paragraphs and page number the disclosure suggest or discloses the amended claim 212 then applicant is introducing new matters and the amendments should be deleted or removed from the amended claim 212.**

### **Claim Rejections - 35 USC § 112**

2. Claim 212 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **applicant has failed to point out specific page and paragraphs the amendments (specifically claim limitations “re-programming of operating elements from an initial state to a selection state, enabled by a providing function triggered by an operating element”) are disclosed and in event applicant failed to point out specific paragraphs and page number the**

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**disclosure suggest or discloses the amended claim 212 then applicant is introducing new matters and the amendments should be deleted or removed from the amended claim 212.**

3. **Status:** Please all replies and correspondence should be addressed to examiner's new art unit 2629. Receipt is acknowledged of papers submitted on 01-06-2011 under amendments and request for continue examination, which have been placed of record in the file. Claims 212, 213, 215-223 and 225-229 are pending. Claims 1-211, 214 and 224 are cancelled.

#### **Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 212, 213, 215-223 and 225-229 are rejected under 35 U.S.C. 102(b) as being anticipated by Lebby et al. (US 5,534,888).

Regarding Claim 212, Lebby et al. (US 5,534,888) discloses a mobile display device (Col. 2, Line 10 suggests electronic book with plurality of displays), in particular for displaying text and image information (Col. 1, Lines 60-64), comprising: a casing having a planar display unit with at least one planar display screen disposed on a first side of the casing (Col. 2, Lines 10-17 discloses book with casing, please also see figure 1, Col. 3, Lines 10-30 discloses planar

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type display such as LCD or liquid crystal display, electroluminescent display); at least one manipulation region for operation by a user, said manipulation region being provided at a border zone of the display unit in such a way that the user can perform operating actions with one or more fingers of one hand (please see figures 1 and 4 item # 117, 417, 118) ; and at least one actuatable operating element that is arranged within the manipulation region on a second side of the casing that faces in a direction different than the first side, wherein actuation of the at least one operating element individually or in combination initiates at least one of leafing-through (please see figures 1-4, item # 116, 316 and 130, 330, 430, Col. 4, Lines 28-40 and scrolling functions to navigate document content displayed on the display screen or to provide functions for selection menus (Col. 5, Lines 2-32 suggests every page has navigation as well as scrolling function Item # 417 besides the front side Item # 117 or different from front side for turning pages or scrolling pages). Further Regarding Claim 212, Lebby et al. (US 5,534,888) discloses the Item 117 are keys or push buttons (Col. 2, Lines 59-64); when book is opened and a planar display is displaying image as well as text data are displayed user can press 117 obviously located in the rear or back side of the display to one ordinary skill in the art to achieve various function while holding the book in the hand, please also see figures 1 and 4 and scrolling functions to navigate document content displayed on the display screen, and providing functions for selection menus (Col. 5, Lines 34-67 suggests a scrolling function is used, providing menu driven function using stylus; pen or finger). Further Regarding Claim 212, Lebby et al. (US 5,534,888) discloses specific operating elements of the at least one actuatable operating element and/or specific touch-sensitive regions of the touch-sensitive touch screen individually or in combination are allocated, in an initial state, to a specific first functionality, immediately after

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activating a providing function for a selection menu, in a selection state, to activate a selection function within the provided selection menu (Col. 2, Line 59 to Col. 3, Line 19, Col. 4, Lines 13-49, suggests manipulation capabilities using various control, buttons and keys provided on the digital book display for scrolling and navigation purposes; Col. 5, Lines 2-67 suggests the communication can be carried out via stylus suggest having a touch screen, also suggests power-up operation controlled by CPU or MPU); Further Regarding Claim 212, Lebby et al. (US 5,534,888) discloses wherein specific operating elements are allocated (figures 1-3, Col. 2, Lines 10-17 suggests the plurality of display pages, sensors associated with each pages, function keys and buttons are operating elements, Col. 2, Lines 50-67, Col. 4, Lines 13-49, Col. 5, Line 46 to Col. 6, Line 34), in an initial state, to a specific first functionality (electronic books is opened the display pages with sensors initially displays the previously displayed pages), and, immediately after triggering a providing function for a selection menu (as soon as the display pages start displaying previously displayed pages the sensors associated senses the display being operational, Col. 2, Lines 10-17, 50-67, Col. 4, Lines 13-49, Col. 5, Line 46 to Col. 6, Line 34), are automatically re-programmed and trigger, in a selection state (the MPU or CPU receiving sensors input start updating all both display page with selected materials or downloading updated material for those specific displays to be read by user and user selects appropriate buttons or keys to select function to be triggered, Col. 2, Lines 10-17, 50-67, Col. 4, Lines 13-49, Col. 5, Line 46 to Col. 6, Line 34), a selection function within the provided selection menu (please see figures 4 and 5, showing the flow chart suggests a selection of function and triggering of the function from the selected menu Col. 2, Lines 10-17, 50-67, Col. 4, Lines 13-49, Col. 5, Line 46 to Col. 6, Line 34).

Regarding Claim 213, Lebby et al. (US 5,534,888) discloses the at least one actuatable operating element includes at least two actuatable operating elements, wherein the arrangement of the at least two actuatable operating elements within the manipulation region is such that the at least two actuatable operating elements can be actuated simultaneously with the fingers of one hand (Col. 4, Lines 13-49).

Regarding Claim 215, Lebby et al. (US 5,534,888) discloses the at least one actuatable operating element includes abutting combination key elements (Col. 4, Lines 13-49).

Regarding Claim 216, Lebby et al. (US 5,534,888) discloses the at least one actuatable operating element includes three abutting combination key elements being arranged such that they are operable by index finger, middle finger and ring finger of a hand holding the mobile display device (Col. 2, Line 59 to Col. 3, Line 19, Col. 4, Lines 21-39).

Regarding Claim 217, Lebby et al. (US 5,534,888) discloses the at least one actuatable operating element includes at least one of directional keys and function keys that can be actuated individually or in combination to provide different functions (Col. 2, Line 59 to Col. 3, Line 19, Col. 4, Lines 13-49).

Regarding Claim 218, Lebby et al. (US 5,534,888) discloses the at least one actuatable operating element is configured such that actuation of an actuatable operating element alone or

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actuatable operating elements in combination causes the display screen to display a next page of a displayed document (Col. 2, Line 59 to Col. 3, Line 19, Col. 4, Lines 13-49, Col. 5, Lines).

Regarding Claim 219, Lebby et al. (US 5,534,888) discloses the at least one manipulation region is disposed such that the user can perform the operating actions without requiring a substantial movement of the carpus of a holding hand of the user relative to the casing (Col. 2, Line 59 to Col. 3, Line 19, Col. 4, Lines 13-49, Col. 5, Lines 15-67).

Regarding Claim 220, Lebby et al. (US 5,534,888) discloses the at least one actuatable operating element includes at least one of a slide pad, a track ball and a multifunction key (Col. 2, Line 59 to Col. 3, Line 19, Col. 4, Lines 13-49, Col. 5, Lines 2-67).

Regarding Claim 221, Lebby et al. (US 5,534,888) discloses at least a portion of the display screen within the manipulation region includes a touch- sensitive touch screen (Col. 2, Line 59 to Col. 3, Line 19, Col. 4, Lines 13-49, suggests manipulation capabilities using various control, buttons and keys provided on the digital book display; Col. 5, Lines 50-67, suggests the communication can be carried out via stylus suggest having a touch screen).

Regarding Claim 222, Lebby et al. (US 5,534,888) discloses at least a border zone of the display screen includes a touch-sensitive touch screen, wherein at least one of a screen corner region and a region in the middle of the border zone is actuatable for initiating specific functions (Col. 2, Line 59 to Col. 3, Line 19, Col. 4, Lines 13-49, suggests manipulation capabilities using



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various control, buttons and keys provided on the digital book display; Col. 5, Lines 2-67 suggests the communication can be carried out via stylus suggest having a touch screen).

Regarding Claim 223, Lebby et al. (US 5,534,888) discloses actuation of at least one of the at least one actuatable operating element and the touch-sensitive touch screen individually or in combination initiates leafing-through or scrolling functions for navigating content of a displayed document, provides functions for selection menus, or selects functions within provided selection menus (Col. 2, Line 59 to Col. 3, Line 19, Col. 4, Lines 13-49, suggests manipulation capabilities using various control, buttons and keys provided on the digital book display for scrolling and navigation purposes; Col. 5, Lines 2-67 suggests the communication can be carried out via stylus suggest having a touch screen).

Regarding Claim 225, Lebby et al. (US 5,534,888) discloses the selection menus are displayed only in a border portion of the display screen without covering content of the displayed document (Col. 2, Line 59 to Col. 3, Line 19, Col. 4, Lines 13-49, suggests manipulation capabilities using various control, buttons and keys provided on the digital book display menu for scrolling and navigation purposes and controlling display suggests the menu displayed on a page and other pages display menu selected information and therefore menu is not covering any portion of the display; Col. 5, Lines 2-67 suggests the communication can be carried out via stylus suggest having a touch screen).

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Regarding Claim 226, Lebby et al. (US 5,534,888) discloses the display unit includes at least two parts (please see figures 1-4).

Regarding Claim 227, Lebby et al. (US 5,534,888) discloses the display unit comprises at least two display screens (please see figure 4, Col. 4, Lines 13-49).

Regarding Claim 228, Lebby et al. (US 5,534,888) discloses the casing includes a main part and at least one ancillary part, wherein the main part and the at least one ancillary part are arranged such that the casing can be opened and shut about a folding axis like a book, and wherein the main part and the at least one ancillary part form a spine element (please see figures 1-4).

Regarding Claim 229, Lebby et al. (US 5,534,888) discloses the main part includes at least one display screen, the at least one ancillary part includes at least one display screen, and the display unit is arranged such that the main part and the at least one ancillary part are presented to a user like pages of a book when the casing is opened (please see figures 1-4).

### **Response to Arguments**

6. Applicant's arguments filed 01-06-2011 have been fully considered but they are not persuasive.

Applicant argue Lebby et al. (US 5,534,888) fails to disclose or suggest the operating element states recited in claim 21.2, That is, Lebby et al. do not disclose or suggest that specific

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operating elements are allocated to a first functionality in an initial state and that, after a providing function for a selection menu is triggered (via. the operating elements), the operating elements are automatically re-programmed so that they are then in. a :selection state, in which the operating elements triggers a selection function within the provided selection menu.

Examiner disagrees as Lebby et al. (US 5,534,888) does disclose all the buttons and keys and sensors associated with the display page; after accessing of the pages produces display of the previous state or initial state please see figures 1-5, Col. 2, Lines 10-17, 50-67, Col. 4, Lines 13-49, Col. 5, Line 46 to Col. 6, Line 34 and sensors senses the display pages are accessed the sensor inputting to MPU or CPU downloads or uploads automatically the updates. User the selects the menu by using keys and buttons located on the display pages and triggers a selection function within the provided selection menu; please see figures 1-5, Col. 2, Lines 10-17, 50-67, Col. 4, Lines 13-49, Col. 5, Line 46 to Col. 6, Line 34.

Applicant argues Lebby et al. (US 5,534,888) fails to disclose or suggest the claimed re-programming of operating elements from an initial state to a selection state, enabled by a providing function triggered by an operating element.

Examiner disagrees, as Lebby et al. (US 5,534,888) does suggests re-programming of operating elements from an initial state to a selection state, enabled by a providing function triggered by an operating element (please see figures 1-5, Col. 2, Lines 10-17, 50-67, Col. 4, Lines 13-49, Col. 5, Line 46 to Col. 6, Line 34 sensors senses the display pages are accessed the sensor inputting to MPU or CPU downloads or uploads automatically the updates. User the selects the menu by using keys and buttons located on the display pages and triggers a selection function within the provided selection menu; and Col. 4, Lines 28-49, suggests the sensors

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associated with each page in communication with CPU or MPU does re-program to initial state to a selection state after reaching final display page or end of the book or last display page).

Applicant argues the prior art of Lebby et al. (US 5,534,888) fails to disclose buttons or keys as input device on the rear of the display.

Examiner disagrees as the prior art of Lebby et al. (US 5,534,888) does suggest the Item 117 are keys or push buttons (Col. 2, Lines 59-64); when book is opened and a planar display is displaying image as well as text data are displayed user can press 117 obviously located in the rear or back side of the display to one ordinary skill in the art to achieve various function while holding the book in the hand, please also see figures 1 and 4. Further Applicant argues the prior art of Lebby et al. (US 5,534,888) fails to disclose scrolling functions to navigate document content displayed on the display screen, and providing functions for selection menus. Examiner disagrees as the prior art of Lebby et al. (US 5,534,888) does disclose scrolling functions to navigate document content displayed on the display screen, and providing functions for selection menus (Col. 5, Lines 34-67 suggests a scrolling function is used, providing menu driven function using stylus; pen or finger).

**Applicant is requested to review all the prior arts listed on PTO 892 as the prior arts do disclose to applicant's claimed invention.**

### **Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Huffman; James R (US 5893132 A) Method and system for encoding a book for reading using an electronic book

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRABODH M. DHARIA whose telephone number is (571)272-7668. The examiner can normally be reached on M-F 8-30AM to 5PM.

9. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

/Prabodh M Dharia/

Primary Examiner

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